IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

	ATTY. DOCKET NO.:	**RAL920000041US1**
IN RE APPLICATION OF:	§	
	§	
CYNTHIA ANN ADIANO	§	**EXAMINER: NORMAN M. WRIGHT**
	§	
SERIAL NO.: 09/733,737	§	**CONFIRMATION NO.: 4788**
	§	
FILED: 08 DECEMBER 2000	§	**ART UNIT: 2134**
	§	
FOR: SECURE ELECTRONIC SOFTWARE DISTRIBUTION	§	
	§	

REPLY BRIEF

Mail Stop Appeal Briefs - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

This Reply Brief is submitted in response to the Examiner's Answer filed on August 10, 2007.

Appellants do not believe that any additional fees or extension of time are due for filing this Reply Brief. In the event that an extension of time is required, that extension of time is hereby requested. In the event that any fees are due, including those required for an extension of time, please charge such fees, as well as any additional required fees, to **IBM CORPORATION DEPOSIT ACCOUNT No. 09-0457**.

ARGUMENTS

A. The Examiner's rejection of Claims 46-52 as being unpatentable under 35 USC 112, second paragraph.

The Examiner's Answer, from pages 12-15, details why the Examiner does not believe that the Specification supports exemplary Claim 46. Appellants believe that this exposition is irrelevant, since the rejection is under the second paragraph, not the first paragraph, of 35 USC 112.

Nonetheless, in an effort to promote the prosecution of the present application, Appellants reply that the specification fully supports the feature of permitting the software application to run only if the e-mail cannot be forwarded ("permitting the software application program to run only if a determination is made that a disabling instruction has been incorporated into the e-mail message that prevents the e-mail message with the appended software application program from being forwarded"). As stated on page 3, lines 13-16:

> The recipient opens the electronic mail message in his mail folder and clicks on an installation button to activate execution of the installation script. After successful completion of the installation the script is marked "used" and cannot be used again. Marking of the installation script as "used" also disables the forwarding mechanism of the electronic mail software to prevent the user from accessing a second copy of the software. When the recipient saves the electronic mail, the "used" flag is set and the script can continue.

That is, only if the "used" flag is set (indicating the disablement of the forwarding mechanism) can the installation script (and thus the running of the software application program) continue.

With regards to the 35 USC 112 second paragraph rejections, Appellants have stated in their Appeal Brief that the phrase "permitting the software application to run...prevent the e-mail message...from being forwarded" need not state "who or whom is permitting the software application from being run or forwarded," as deemed necessary by the Examiner. It is axiomatic that breadth is not indefiniteness (*MPEP § 2173.04*).

For the reasons cited, the claim is clear, definite, and supported by the specification, and this rejection should be withdrawn.

B. The Examiner's rejection of Claims 46-51, 64-69 and 70-75 as being unpatentable under 35 USC 103(a) over *Olkin, et al.* (U.S. Patent No. 6,584,564 –"*Olkin*") in view of *Leonard, et al.* (U.S. Patent No. 6,721,784 – "*Leonard*").

In the Examiner's Answer, the Examiner reiterates his argument regarding the feature of "permitting the software application program to run only if a determination is made that a disabling instruction has been incorporated into the e-mail message that prevents the e-mail message with the appended software application program from being forwarded," which will not be re-addressed here. The Examiner then states that Appellants assert that there is no reason to combined the prior art. Appellants have not asserted this to date, since there is nothing to combine in the prior art to arrive at the presently claimed invention, as claimed in exemplary Claim 46. The only way to arrive at the feature of "permitting the software application program to run only if a determination is made that a disabling instruction has been incorporated into the e-mail message that prevents the e-mail message with the appended software application program from being forwarded" is to use the teachings of the present invention.

Thus, these rejections should be withdrawn.

C. The Examiner's rejection of Claim 52 as being unpatentable under 35 USC 103(a) over *Olkin, et al.* (U.S. Patent No. 6,584,564 –"*Olkin*") in view of *Leonard, et al.* (U.S. Patent No. 6,721,784 – "*Leonard*").

The cited art does not teach or suggest "permitting the software application program to run only if a determination is made that the e-mail message with the appended software application program was received by the receiving computer from a pre-specified e-mail server." The Examiner correctly states in his Examiner's Answer that *Olkin* teaches that "only a specified user receives and utilizes the e-mail." However, this does not teach or suggest that the e-mail must come from a "pre-specified e-mail server" in order to permit the software application

program to run.

Thus, this rejection should be withdrawn.

D. The Examiner's rejection of Claim 58 as being unpatentable under 35 USC 103(a) over *Olkin, et al.* (U.S. Patent No. 6,584,564 –"*Olkin*") in view of *Leonard, et al.* (U.S. Patent No. 6,721,784 – "*Leonard*").

With regards to Claim 58, the cited art does not teach or suggest "in response to determining that the e-mail was not saved by the receiving computer, discontinues an installation on the receiving computer of the appended software application program." The Examiner states in his Examiner's Answer that all e-mail must be saved, or else it couldn't be in a user's Inbox. Thus, the limitation of saving the e-mail "by the receiving computer" as a pre-requisite for avoiding the discontinuation of an installation of the software application is illogical.

As stated on page 9, lines 1-14 of the specification, e-mail storage can be server-based. It is not mandatory that e-mail storage be user-based. Thus, the limitation is reasonable, logical and properly supported. Regarding the Examiner's suggestion that e-mail must be in a local buffer to work, and thus is "saved" by the client device, Appellants rely on the well-known definition of "save" as "to write data to a storage medium, such as a disk or tape" (See Microsoft Press Computer Dictionary, Third Edition – copy attached.) E-mail temporarily stored in a buffer or system memory is not "saved."

For the reasons stated, this rejection should be withdrawn.

E. The Examiner's rejection of Claim 61 as being unpatentable under 35 USC 103(a) over *Olkin, et al.* (U.S. Patent No. 6,584,564 –"*Olkin*") in view of *Leonard, et al.* (U.S. Patent No. 6,721,784 – "*Leonard*").

With regards to Claim 61, the cited art does not teach or suggest "enabling the appended software application program only if the received and decrypted serial number matches the

stored serial number." The Examiner first took "official notice of both the motive and modification necessary for having a local processor store its identifying information/serial number/machine identify in an encrypted registry as part of a validation/installation process" of this feature as claimed in Claim 61 in the August 26, 2005 Final Office Action. Claim 61 was added in Appellants' May 2, 2005 amendment, and thus was not a pending claim when the January 31, 2005 non-final Office Action was mailed. When the Examiner took official notice that this feature is "common knowledge," Appellants timely traversed in their October 26, 2005 amendment. Thus, the Examiner's statement, in the Examiner's Answer, that the official notice "was not seasonably challenged in the next official correspondence to the office" is inaccurate.

Thus, this rejection should be withdrawn.

F. The Examiner's rejection of Claim 63 as being unpatentable under 35 USC 103(a) over *Olkin, et al.* (U.S. Patent No. 6,584,564 –"*Olkin*") in view of *Leonard, et al.* (U.S. Patent No. 6,721,784 – "*Leonard*").

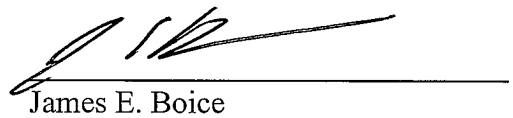
With regards to Claim 63, the cited art does not teach or suggest that "the appended software application program can be installed on the receiving computer only once." *Olkin* teaches that an e-mail can be read a limited number of times (col. 9, lines 32-36), but makes no suggestion about limiting how often the appended software can be installed on the computer. The Examiner states in his Examiner's Answer that an e-mail can be opened only once, but this is unrelated to installing the appended software applications program only once.

Thus, this rejection is not well founded and should be reversed.

CONCLUSION

Appellants have pointed out with specificity the manifest error in the Examiner's rejections, and the claim language which renders the invention patentable over the various combinations of references. Appellants, therefore, respectfully request that this case be remanded to the Examiner with instructions to issue a Notice of Allowance for all pending claims.

Respectfully submitted,



James E. Boice
Reg. No. 44,545
DILLON & YUDELL LLP
8911 N. Capital of Texas Highway
Suite 2110
Austin, Texas 78759
512-343-6116

ATTORNEY FOR APPELLANTS

Microsoft Press

Computer Dictionary

Third Edition

Microsoft Press

PUBLISHED BY
Microsoft Press
A Division of Microsoft Corporation
One Microsoft Way
Redmond, Washington 98052-6399

Library of Congress Cataloging-in-Publication Data
Microsoft Press Computer Dictionary. -- 3rd ed.
p. cm.
ISBN 1-57231-446-X
1. Computers--Dictionaries. 2. Microcomputers--Dictionaries.
I. Microsoft Press.
QA76.15.M54 1997
004'.03--dc21 97-15489
CIP

Printed and bound in the United States of America.

1 2 3 4 5 6 7 8 9 QMQM 2 1 0 9 8 7

Distributed to the book trade in Canada by Macmillan of Canada, a division of Canada Publishing Corporation.

A CIP catalogue record for this book is available from the British Library.

Microsoft Press books are available through booksellers and distributors worldwide. For further information about international editions, contact your local Microsoft Corporation office. Or contact Microsoft Press International directly at fax (425) 936-7329.

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ments at the upper and lower ends of the strokes). A sans serif typeface usually possesses a more straightforward, geometric appearance than a typeface with serifs and typically lacks the contrast between thick and thin strokes found in serif faces. Sans serif typefaces are used more frequently in display type, such as headlines, than in blocks of text. *Compare* serif[1].

SAP \S`A-P´\ *n.* *See* Service Advertising Protocol.

SAPI \S`A-P-I´\ *n.* Acronym for **S**peech **A**pplication **P**rogramming **I**nterface. A feature in Windows 95 and Windows NT that allows applications to include speech recognition or convert text to speech. *Also called* Speech API. *See also* speech recognition.

satellite \sat´ə-līt`\ *n.* *See* communications satellite.

satellite computer \sat´ə-līt kəm-pyo͞o`tər\ *n.* A computer that is connected to another computer, with which it interacts over a communications link. As its name indicates, a satellite computer is of lesser "stature" than the main, or host, computer; the host controls either the satellite itself or the tasks the satellite performs. *See also* remote communications.

saturated mode \sach´ər-ā-təd mōd`\ *n.* The state in which a switching device or amplifier is passing the maximum possible current. A device is in saturated mode when increasing the control signal does not result in output of additional current.

saturation \sach`ər-ā´shən\ *n.* **1.** In a switching device or amplifier, the fully conducting state. At saturation, the device is passing the maximum possible current. The term is most commonly used with reference to circuits containing bipolar or field-effect transistors. **2.** In color graphics and printing, the amount of color in a specified hue, often specified as a percentage. *See also* HSB.

save \sāv\ *vb.* To write data (typically a file) to a storage medium, such as a disk or tape.

.sb \dot`S-B´\ *n.* On the Internet, the major geographic domain specifying that an address is located in the Solomon Islands.

.sc \dot`S-C´\ *n.* On the Internet, the major geographic domain specifying that an address is located in Seychelles.

scalable \skā´lə-bl`\ *adj.* Of or relating to the characteristic of a piece of hardware or software that makes it possible for it to expand to meet future needs. For example, a scalable network allows the network administrator to add many additional nodes without the need to redesign the basic system.

scalable font \skā`lə-bl font´\ *n.* Any font that can be scaled to produce characters in varying sizes. Examples of scalable fonts are screen fonts in a graphical user interface, stroke fonts (such as Courier) and outline fonts common to most PostScript printers, TrueType fonts, and the method for screen font definition used in Macintosh System 7. In contrast, most text-based interfaces and printing devices (such as daisy-wheel printers) offer text in only one size. *See also* outline font, PostScript font, screen font, stroke font, TrueType.

scalable parallel processing \skā´lə-bl pâr`ə-lel pros´es-ēng\ *n.* Multiprocessing architectures in which additional processors and additional users can easily be added without excessive increases in complexity and loss of performance. *Acronym:* SPP (S`P-P´).

Scalable Processor Architecture \skā`lə-bl pros-es-er är´kə-tek-chur\ *n.* *See* SPARC.

scalar \skā´lər\ *n.* A factor, coefficient, or variable consisting of a single value (as opposed to a record, an array, or some other complex data structure). *Compare* vector.

scalar data type \skā`lər dā´tə tīp, dat´ə\ *n.* A data type defined as having a predictable and enumerable sequence of values that can be compared for greater-than/less-than relationships. Scalar data types include integers, characters, user-defined enumerated data types, and (in most implementations) Boolean values. Some debate exists as to whether or not floating-point numbers can be considered a scalar data type; although they can be ordered, enumeration is often questionable because of rounding and conversion errors. *See also* Boolean expression, enumerated data type, floating-point number.

scalar processor \skā´lər pros`es-er\ *n.* A processor designed for high-speed computation of scalar values. A scalar value can be represented by a single number.

scalar variable \skā´lər vâr`ē-ə-bl\ *n.* *See* scalar.

scale[1] \skāl\ *n.* A horizontal or vertical line on a graph that shows minimum, maximum, and interval values for the data plotted.